

Response to Office Action Mailed April 4, 2008

Inventors: Christodorescu, et al.

U.S. Ser. No. 10/629,292

Page 5 of 8

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the reasons that follow. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

No claims are being amended, added, or cancelled. Accordingly, claims 1-17 remain pending in this application.

**35 USC §101 Rejections**

In the §101 section of the Office Action, the Examiner rejected claims 1-17 under 35 USC §101 as being directed to non-statutory subject matter. The Examiner argued that “computer readable storage medium” is not defined in the specification. The Examiner argues that the context the medium was used in the claims would fairly suggest to one ordinary skill signals or other forms of propagation and transmission media, typewritten or handwritten text on paper, or other items failing to be an appropriate manufacture under 35 USC 101 in the context of computer-related inventions. Applicants respectfully traverse with the Examiner’s argument.

It is unclear from the Examiner’s statements whether the Examiner is making a new matter rejection or a 101 rejection. The present application specifically states in claims 1-17 that the claimed invention is directed to a computer program stored on a computer-readable medium. This is well known as being statutory subject matter. MPEP §2106.01 states “A claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of

Response to Office Action Mailed April 4, 2008

Inventors: Christodorescu, et al.

U.S. Ser. No. 10/629,292

Page 6 of 8

the computer which permit the computer program's functionality to be realized, and is thus statutory." There is no definition in the specification that would modify the ordinary accepted meaning of these terms. Accordingly, Applicants assert that the rejection under §101 is improper and should be withdrawn.

Even if the Examiner is asserting that computer-readable medium is not described and that the amendment constitutes new matter, Applicants respectfully disagree. The claimed application is directed to computer programs that operate "in a computer that uses hardware and/or software to prevent the executing program from damaging interaction with the computer," as is made clear in the Background of the Invention. (Application, paragraph [0004])

### **35 USC §103 Rejections**

In the §103 section of the Office Action, the Examiner rejected claims 1-3 and 6-10 under USC §103(a) as being anticipated by U.S. Patent No. 6,357,008 to Nachenberg (hereinafter "Nachenberg") in view of Christodorescu "Detecting Malicious Patterns in Executables via Model Checking" University of Wisconsin, July 12, 2002, page 1-15 (hereinafter "Christodorescu"). The Examiner recognized that "Nachenberg does not explicitly disclose creating a logically equivalent standardized version of the suspect program without executing the program." Applicants respectfully traverse the rejection by the Examiner.

Response to Office Action Mailed April 4, 2008

Inventors: Christodorescu, et al.

U.S. Ser. No. 10/629,292

Page 7 of 8

Christodorescu Reference is not Prior Art

The date cited by the Examiner and appearing on the face of Christodorescu is not a date that the reference was available to the public. The reference is not prior art to the present application.

As previously stated by the Applicant, in Nachenberg, the original executable program is executed in a virtual environment. The original executable program cannot be considered a logically equivalent standardized version since this executable is neither logically equivalent nor standardized as recited in claim 1 and described in the present application. Accordingly, Nachenberg does not teach nor suggest all of the elements of claim 1. This deficiency cannot be cured by Christodorescu since this reference is not prior art. Reconsideration and allowance of claim 1 is respectfully requested.

Dependent Claims 2-3 and 6-10

Claims 2-3 and 6-10 depend from claim 1 and include all of the limitations thereof. These claims are allowable for at least the same reasons as the independent claims from which they depend. Reconsideration and allowance of claims 2-3 and 6-10 is respectfully requested.

Claims 4-5 and 11-17

Also in the §103 section of the Office Action, the Examiner rejected claims 4-5 and 11-17 under USC §103(a) as being unpatentable over Nachenberg in view of Christodorescu and further in view of U.S. Patent No. 7,188,369 to Ho, et al. (hereinafter “Ho”). The Examiner stated that Ho discloses “wherein the standardized version maps instructions of the suspect

Response to Office Action Mailed April 4, 2008

Inventors: Christodorescu, et al.

U.S. Ser. No. 10/629,292

Page 8 of 8

program to corresponding standard synonym instructions." (citing Ho, col. 5, line 25 – col. 6, line 40) Applicants respectfully disagree and traverse the rejection of the Examiner.

Claims 4-5 and 11-17 depend from claim 1 and includes all of the limitations thereof. Ho does not cure any of the above noted deficiencies of Nachenberg and Christodorescu. Accordingly, these claims are allowable for at least the same reasons as the independent claims from which they depend. Reconsideration and allowance of claims 4-5 and 11-17 is respectfully requested.

Conclusion

Applicants believe that the present application is in a condition for allowance. Applicants appreciate consideration of the above remarks and invites that the Examiner to telephone the undersigned in the event a telephone discussion would be helpful in advancing the prosecution of the present application. The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-1170.

Respectfully submitted,

By



Michael S. Brayer

Reg. No. 51,495

Attorney for Applicant

BOYLE FREDRICKSON, S.C.

840 N. Plankinton Ave.

Milwaukee WI 53203

(414) 225-6305

August 4, 2008